

January 5, 2009
CST

In re application of	:	DECISION ON REQUEST TO
David Wollan	:	PARTICIPATE IN PATENT
Serial No. 10/563,636	:	PROSECUTION HIGHWAY
Filed: March 14, 2008	:	PILOT PROGRAM AND
For: ALCOHOL REDUCTION IN	:	PETITION TO MAKE SPECIAL
BEVERAGES	:	UNDER 37 CFR 1.102(d)

This is a decision on the request to participate in the Patent Prosecution Highway (PPH) program and the petition under 37 CFR 1.102(d) to make the above-identified application special, filed November 4, 2008.

The request and petition are **DISMISSED**.

A grantable request to participate in the PPH program and petition to make special require:

(1) The U.S. application must validly claim priority under 35 U.S.C. 119(a) to one or more applications filed in the IPAU, note where the IPAU application with similar claims is not the same application from which the U.S. application claims priority that the applicant must identify the relationship between the IPAU application with similar claims and the IPAU priority application;

(2) Applicant must submit a copy of:

- a. The allowable/patentable claim(s) from the IPAU application(s) or if a copy of the allowable/patentable claims is available via the Dossier Access System (DAS) applicant may request the USPTO to obtain a copy from DAS; however, if the USPTO is unable to obtain a copy from the DAS, the applicant will be required to submit a copy;
- b. An English translation of the allowable/ patentable claim(s), if applicable; and
- c. A statement that the English translation is accurate, if applicable;

(3) Applicant must:

- a. Ensure all the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the IPAU application(s); and
- b. Submit a claims correspondence table in English;

(4) Examination of the U.S. application has not begun;

(5) Applicant must submit:

- a. Documentation of prior office action:
 - i. a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the IPAU application(s) containing the allowable/patentable claims(s) or
 - ii. if the allowable/patentable claim(s) are from "Notification of Reasons for Refusal" then the Notification of Reasons for Refusal or
 - iii. if the IPAU application is a first action allowance then no office action from the IPAU is necessary should be indicated on the request/petition form:
Further, if a copy of the documents from a or b is available via the Dossier Access System (DAS), applicant may request the USPO obtain a copy from the DAS; however, if the USPTO is unable to obtain a copy of the DAS, the applicant will be required to submit a copy;
- b. An English language translation of the IPAU Office action from (5)(a)(i)-(ii) above if applicable; and
- c. A statement that the English translation is accurate;

(6) Applicant must submit:

- a. An IDS listing the documents cited by the IPAU examiner in the IPAU office action (unless already submitted in this application)
- b. Copies of documents except U.S. patents or U.S. patent application publications (unless already submitted in this application); and

(7) The required petition fee under 37 CFR 1.17(h).

The request to participate in the PPH program and petition fail because:

(3) All of the claims in the U.S. application must sufficiently correspond or be amended to sufficiently correspond to the allowable/patentable claim(s) in the IPAU application(s).

Specifically, claim 21 does not include the limitation that the solution contacts the membrane on the side opposite to that contacted by the raw permeate, as required in corresponding claim 16 of the IPAU application. The word -side- is missing from the claim.

(5) Applicant must submit documentation of prior office action. Specifically, a copy of the office action(s) just prior to the "Decision to Grant a Patent" from each of the IPAU application(s) containing the allowable/patentable claims(s).

Although it appears that applicant has provided a copy of the response prepared by applicant dated December 20, 2007 to the first official report, as well as the Notice of

Acceptance dated January 9, 2008 from IP Australia, a copy of the first official report from IP Australia has not been provided as required by item 5 above.

Applicant is given a time period of **ONE MONTH OR THIRTY DAYS**, whichever is longer, from the mailing date of this decision to correct the deficiencies. **NO EXTENSION OF TIME UNDER 37 CFR 1.136 IS PERMITTED.** If the deficiencies are not corrected within the time period given, the application will await action in its regular turn.

Any inquiry regarding this decision should be directed to Christine Tierney, Quality Assurance Specialist, at (571) 272-1055.

All other inquiries concerning the examination or status of the application is accessible in the PAIR system at <http://www.uspto.gov/eac/index.html>.

/Christine Tierney/

Christine Tierney
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